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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,673	07/15/2003	Jerome O. Blomberg	32275/0004	9646
30983	7590	04/26/2005	EXAMINER	
MCDONOUGH, HOLLAND & ALLEN 555 CAPITOL MALL 9TH FLOOR SACRAMENTO, CA 95814			CANFIELD, ROBERT	
		ART UNIT	PAPER NUMBER	3635

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/620,673	BLOMBERG, JEROME O.
	Examiner Robert J Canfield	Art Unit 3635

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 January 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 12-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/15/03 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

1. This Office action is in response to the amendment filed 01/10/05. Claims 1-10 and 12-24 are pending. Claim 11 has been canceled.
2. Claim 21 is objected to because of the following informalities: it appears that the word "the" is missing before "longitudinal". Appropriate correction is required.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-4, 6-10, 12, 13, 15-17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,236,350 to Hasselbach.

Figure 3 shows the arch shape. Figure 2 shows the apex being shorter than the base. Corrugations 34 are provided on the main body. End portions 31 and 32 are provided with corrugations and flange 31' is provided. The corrugations are perpendicular to the longitudinal axis, angled, and capable of being positioned/oriented perpendicular to sunlight having a low angle of incidence.

5. Claims 1-4, 6, 12, 14 and 16-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Des. 273,045 to Artwick.

Figure 2 clearly shows end walls at approximately 45 degrees, corrugated main body portion and an attachment flange. Figure 4 shows the arch shape. The corrugations are perpendicular to the longitudinal axis, angled, and capable of

being positioned/oriented perpendicular to sunlight having a low angle of incidence.

6. Claims 1-4 and 6-24 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 92/02697.

The WO patent shows various embodiments of multiple layer arch shaped skylights having an attachment flange and corrugated main body portion. The corrugations are perpendicular to the longitudinal axis, angled, and capable of being positioned/oriented perpendicular to sunlight having a low angle of incidence.

7. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,236,350 to Hasselbach.

The angle of the end walls as well as the parabola arch shape are viewed as choices of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Hasselbach suggests that modifications may be made and there is no particular significance attributed to the features by applicant.

8. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Des. 273,045 to Artwick.

As Artwick is a design patent it is inherently silent as to the material. It would have been obvious at the time of the invention to one having ordinary skill in the art that the cover of Artwick could have been made from a light transmitting plastic material as such materials are well known for window covers for their inherent material properties. The method of manufacture is not required to be met in an apparatus claim. Light transmitting plastic is inherently prismatic.

9. In response to applicant's argument that Hasselbach and Artwick fail to teach skylights, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Further, the recitation skylight has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant's argument that the Paganelli reference fails to provide a main body arched along its longitudinal axis and having an apex is not found persuasive. The term arch is not limited to curves as shown in the definitions below found at www.dictionary.com ("or flat upper edge of an open space"). Apex is defined as a highest point, usually pointed. Any point along the top of the device of Paganelli is considered a highest point. The "usually pointed" definition implies that pointed is not required.

**arch<sup>1</sup>**  **Pronunciation Key** (ärch)  
*n.*

1. A structure, especially one of masonry, forming the curved, pointed, or flat upper edge of an open space and supporting the weight above it, as in a bridge or doorway.
2. A structure, such as a freestanding monument, shaped like an inverted U.
3. A curve with the ends down and the middle up: *the arch of a raised eyebrow*.
4. **Anatomy.** An organ or structure having a curved or bowlike appearance, especially either of two arched sections of the bony structure of the foot.

**v. arched, arch·ing, arch·es**

*v. tr.*

1. To provide with an arch: *arch a passageway*.
2. To cause to form an arch or similar curve.
3. To bend backward: *The dancers alternately arched and hunched their backs*.
4. To span: "the rude bridge that arched the flood" (Ralph Waldo Emerson).

*v. intr.*

To form an arch or archlike curve: *The high fly ball arched toward the stands*.

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[Middle English, from Old French arche, from Vulgar Latin \*arca, from Latin arcus.]

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arch

adj 1: (of persons) highest in rank or authority or office; "his arch rival" [syn: arch(a)] 2: (used of behavior or attitude) characteristic of those who treat others with condescension [syn: condescending, patronizing, patronising] 3: expert in skulduggery; "an arch criminal" [syn: arch(a)] n 1: a curved shape in the vertical plane that spans an opening 2: a curved bony structure supporting or enclosing organs (especially arches of the feet) 3: a passageway under an arch [syn: archway] 4: (architecture) a masonry construction (usually curved) for spanning an opening and supporting the weight above it v : form an arch or curve; "her back arches"; "her hips curve nicely" [syn: curve, arc]

Source: *WordNet ® 2.0*, © 2003 Princeton University

a·pex  **Pronunciation Key** (ə'pĕks)

n. pl. a·pex·es or a·pi·ces (ə'pĕs'ĕz, ăp'ĕs'ĕz)

1. The highest point; the vertex: *the apex of a triangle; the apex of a hill.*
2. The point of culmination. See Synonyms at summit.
3. The usually pointed end of an object; the tip: *the apex of a leaf.*

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[Latin.]

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Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*

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a·pex (ə'pĕks)

n. pl. a·pex·es or a·pi·ces (ə'pĕs'ēz, əp'īs'-)

The pointed end of a conical or pyramidal structure.

Source: The American Heritage® Stedman's Medical Dictionary  
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The examiner notes that applicant has failed to traverse the 35 U.S.C. 103  
obvious choices of design rejections.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

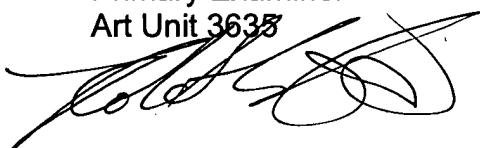
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield  
Primary Examiner  
Art Unit 3635



04/20/05